

REMARKS

In the above-noted Official Action, claims 15-19 and 23-38 were withdrawn from consideration as being non-elected by Applicants in a previous Response to a Restriction Requirement. Claims 21 and 22 were rejected under 35 U.S.C. §112, second paragraph as indefinite. Claims 14, 21 and 22 were rejected under 35 U.S.C. §103(a) over ANJO (U.S. Patent No. 5,056,014). Claims 14, 21 and 22 were also rejected under 35 U.S.C. §103(a) over ANJO in view of KAMADA (U.S. Patent No. 5,595,560) and WATANABE (U.S. Patent No. 5,297,022).

Applicants traverse the rejection of claims 21 under 35 U.S.C. §112, second paragraph. In this regard, the outstanding Official Action asserts that the term “efficiency” is indefinite. However, the meaning of “efficiency” can be well understood by one of ordinary skill in the art, particularly insofar as the term is further defined in claims 22-24 to which one of ordinary skill in the art could turn. Further, the Examiner previously implicitly indicated that he understood these claims (i.e., and their definitions of “efficiency”) when they were subjected to Restriction as different inventions. In any case, the Examiner’s assertion that the term is “too broad” is not a proper basis upon which a rejection may properly be based under 35 U.S.C. §112, second paragraph. Further, insofar as the term “efficiency”, as recited in claim 21, is defined in claims 22-24, Applicants respectfully submit that this is evidence that claim 21 (and by extension, claim 14) is generic to the various Species previously identified by the Examiner as distinct in claims 22-24.

Applicants also traverse the rejection of claim 22 under 35 U.S.C. §112, second paragraph. In this regard, the outstanding Official Action asserts that the term “maximizing” is

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indefinite. However, the term “maximizing” can be well understood by one of ordinary skill in the art.

In this regard, the outstanding Official Action questions how “a measure of the flatness of the finished surface” is maximized. Applicants respectfully submit that the manner in which “a measure of the flatness of the finished surface” is maximized is not necessary to the understanding of the invention recited in claims 14, 21 and 22 (i.e., which is directed to a “method of preparing a program for a punch press”), and the answer to the question is not necessary for one of ordinary skill in the art to interpret Applicants’ claimed invention. Further, the outstanding Official Action questions the “standard upon which this may be determined”. Applicants respectfully submit that exemplary measures of flatness could be determined with reference to a standard textbook, but requires no particular definition to be understood. Finally, the outstanding Official Action questions “how does the number of tool replacements affect the ‘flatness’”. Applicants respectfully submit that claim 22 does not recite that the number of tool replacements affect the flatness; rather, claim 22 recites “the maximized efficiency of the program preparing method is determined by minimizing the total number of punch replacements and die replacements offset by maximizing a measure of the flatness of the finished surface”. Accordingly, Applicants respectfully submit that the answers to the questions are either not necessary to understanding the scope of claims 21 and 22 and/or could be answered by one of ordinary skill in the art with reference to the recitations of Applicant’s claims, including claims withdrawn previously though they depend from and further define the invention recited in claims 14 and 21.

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Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 21 and 22 under 35 U.S.C. §112, second paragraph. Applicants further request that the Examiner acknowledge that claims 14 and 21 are generic to the invention recited in at least each of claims 22-24, insofar as each of claims 22-24 depend from claims 14 and 21 and further define the invention recited in claims 14 and 21.

Applicants traverse the rejection of claim 14 under 35 U.S.C. §103(a) over ANJO and under 35 U.S.C. §103(a) over ANJO in view of KAMADA and WATANABE. In this regard, the outstanding Official Action asserts that it would be obvious to modify ANJO with the teachings of KAMADA to provide a separate identification reader and medium for the die. Applicants respectfully submit that this assertion is in error, as there is no teaching in the ANJO or KAMADA to modify ANJO to include a separate identification reader and medium for the die and for the punch. In particular, the Official Action admits that KAMADA does not itself disclose such a feature. Further, ANJO specifically discloses at, e.g., col. 4, lines 5-8, that “bar codes on each of the punches or dies 17, are sequentially read” by the sensor 43/bar code reader 51. Thus, separate readers and media are not disclosed therein. Applicants additionally note that the Official Action specifically applies KAMADA for teachings similar to the above-noted teachings of ANJO. In other words, KAMADA and ANJO already provide means for reading bar codes/identification media on punches and dies, but do not disclose providing a configuration with separate readers for punches and dies.

Accordingly, modification of ANJO with the identification media reader 40 of KAMADA would still not obtain the invention recited in claim 14, which includes separate

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readers for the punches and dies. Applicants further submit that the only motivation to modify ANJO in the manner necessary to obtain the above-noted feature recited in claim 14 is the Examiner's improper motivation to obtain Applicants' claimed invention in hindsight.

Further, the outstanding Official Action asserts that minimizing the number of replacements is inherent in ANJO because tool replacements are "minimized merely by allowing the control to select the tools mounted on the turret". Applicants respectfully submit that this is untrue, as ANJO does not disclose any functional benefits that could be realized with the tool position recognizing device other than providing the operator with the ability to recognize the tools mounted on a turret. In particular, ANJO does not in any way teach minimizing the replacement of punches and dies, nor are any criteria provided in ANJO for determining how to minimize replacement of punches and dies.

Additionally, the minimizing of replacement of punches and dies is not necessarily a feature of ANJO, as would be required for such a feature to be inherently disclosed. Rather, ANJO is not concerned with minimizing tool replacements, and does not provide any criteria for minimizing tool replacements. Further, the Official Action contradicts the assertion that the minimizing is inherent in ANJO, by later asserting that it would be obvious to modify ANJO with the teachings of WATANABE to possess such a feature (i.e., such that ANJO would require modification to possess such a feature). Accordingly, Applicants respectfully submit that ANJO does not inherently disclose or suggest the above-noted feature recited in claim 14.

The outstanding Official Action also asserts that it would be obvious to modify ANJO with the teachings of WATANABE to minimize tool changing operations. Applicants

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respectfully submit that this assertion is in error. In this regard, WATANABE is not directed to using “punch identification media” or “die identification media” to minimize tool changing operations; rather the portions of WATANABE applied in the Official Action only recognize the general desirability of minimizing tool changing operations. However, the outstanding Official Action does not cite any proper motivation to modify ANJO with the teachings of WATANABE; rather, the Official Action has only taken the isolated teachings of WATANABE and improperly utilized the Examiner’s own hindsight motivation for modifying ANJO with these teachings.

Accordingly, Applicants respectfully request reconsideration and withdrawal of each of the rejections of claims 14, 21 and 22 under 35 U.S.C. §103(a). In particular, Applicants respectfully submit that minimizing the replacements of punches and dies is not “inherent” in ANJO, and that the outstanding Official Action implicitly admits this by asserting that it would be obvious to modify ANJO with the teachings of WATANABE. Further, there is no motivation in the references to modify ANJO with the teachings of KAMADA to obtain such a feature, as neither ANJO nor KAMADA disclose separate readers for punches and dies. Applicants further submit that there is no proper motivation to modify ANJO with the teachings of WATANABE to minimize replacements of punches and dies (i.e., no motivation provided in ANJO or flowing from any other reference to modify ANJO). Accordingly, Applicants submit that the only motivation to modify ANJO in the manner necessary to obtain the invention recited in Applicants’ claims is the Examiner’s improper motivation to obtain Applicants’ claimed invention in hindsight.

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Accordingly, Applicants submit that a clear basis exists for a finding of patentability of the pending claims included in the present amendment. Applicants respectfully request an indication to such effect.

SUMMARY AND CONCLUSION

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have discussed the disclosure of the reference relied upon in the outstanding Official Action and have pointed out specific features of the claims not disclosed by the reference. Applicants have further discussed the features recited in Applicants' claims and have pointed out how these features are not taught, disclosed nor rendered obvious by the disclosure of the references applied in the Official Action. Accordingly, Applicants have provided a clear evidentiary basis supporting the patentability of all the claims pending in the present application and respectfully request an indication to such effect, in due course.

Should there be any questions, the Examiner is invited to contact the undersigned at the below listed number.

Respectfully submitted,
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